

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Atty. Docket

ELMO M.A. DIEDERIKS ET AL.

PHNL020628

SERIAL NO.: 10/519,066

GROUP ART UNIT: 2624

FILED: December 22, 2004

EXAMINER: E. Park

CONFIRMATION NO.: 7327

METHOD OF AND SYSTEM FOR CONTROLLING AN AMBIENT LIGHT AND LIGHTING UNIT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE UNDER 37 C.F.R. 41.37

This is in response to the Notification of Non-Compliant Appeal Brief mailed June 23, 2009.

Appellants' attorney would like to thank Supervisory Patent Examiner Samir A. Ahmed for the telephone conference on July 15, 2009, during which SPE Ahmed indicated that Examiner Park was in error in the above Notification, and that the Appeal Brief filed March 23, 2009, is indeed compliant.

In particular, while Examiner Park had checked off paragraphs 4-6, this is erroneous in that: (para. 4) - the Appeal Brief does "contain a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number and to the drawings, if any, by reference characters; and/or (b) the brief

fails to: (1) identify, for each independent claim involved in the appeal and for each dependent claim argued separately, every means plus function and step plus function under 35 U.S.C. 112, sixth paragraph, and/or (2) set forth the structure, material, or acts described in the specification as corresponding to each claimed function with reference to the specification by page and line number, and to the drawings, if any, by reference characters (37 CFR 41.37(c)(1)(v))." (see section (v) on pages 7-11 of the Appeal Brief); (para. 5) - the Appeal does contain "a concise statement of each ground of rejection presented for review (37 CFR 41.37(c)(1)(vi))" (see section (vi) on page 12 - there was only one 35 U.S.C. 102(b) rejection and one 35 U.S.C. 103(a) rejection); and (para. 6) - the Appeal Brief does present "an argument under a separate heading for each ground of rejection on appeal (37 CFR 41.37(c)(1)(vii))." (see section (vii) on pages 13-19, and in particular, on pages 13 and 16).

Further, Examiner Park indicates in paragraph 10:

"Appellant is advised that all claims on appeal must be summarized and arguments should be made for each and every claim being appealed. The section, 'Summary of Claimed Subject Matter' does not recite claims 5, 6, 7 and does not summarize the missing claims. Furthermore, the 'Argument' section does not consist of arguments for claims 4, 5, 6, 7, 9, 10, 11. Appellant is notified that that the summary section does not address claims 5-7 and the argument section does not address claims 4-7, 9-11. Appellant is required to file a corrected Appeal Brief properly addressing the defective nature of the appeal brief in regards to the two sections as indicated above and to correct other sections as maybe required."

Appellants' attorney asserts that these requirements are contrary to and not supported by 37 C.F.R. 41.37 as described in detail in MPEP §1205.

Appellants' attorney therefore submits that the Appeal Brief filed on March 23, 2009, is indeed compliant and respectfully requests that it be processed in accordance with BPAI procedures.

Respectfully submitted,

by /Edward W. Goodman/
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